



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/243,008	02/02/99	SEED	B 00786/270002

PAUL T CLARK
FISH AND RICHARDSON
225 FRANKLIN STREET
BOSTON MA 02110-2804

HM12/0901

EXAMINER

NOLAN, P

ART UNIT

PAPER NUMBER

1644

DATE MAILED:

09/01/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/243,008

Applicant(s)

Seed et al.

Examiner

NOLAN

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 2-2-99.
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 44-17, 51-52, 56-57, 60-64, 66, 70, 72-75, 77, 79-82 and 92-100 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☐ Claim(s) _____ is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☒ Claim(s) 44-47, 51-52, 56-56, 60-64, 66, 70, 72-75, 77, 79-82, 92-100 are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Part III DETAILED ACTION

1. **Please Note:** In an effort to enhance communication with our customers and reduce processing time, Group 1640 is running a Fax Response Pilot for Written Restriction Requirements. A dedicated Fax machine is in place to receive your responses. The Fax number is 703-305-3704. A Fax cover sheet is attached to this Office Action for your convenience. We encourage your participation in this Pilot program. If you have any questions or suggestions please contact Paula Hutzell, Supervisory Patent Examiner at 703-308-4310. Thank you in advance for allowing us to enhance our customer service. Please limit the use of this dedicated Fax number to responses to Written Restrictions.

2. Claims 44-47, 51-52, 56-57, 60-64, 66, 68, 70, 72-75, 77, 79-82 and 92-100 are pending.

Restriction/Election

3. Restriction to one of the following inventions is required under 35 U.S.C. 121:

Group I. Claims 44-47, 51-52, 56-57, 60-64, 66, 68, 70, 72-75, 77, 79-82 and 100, drawn to cells with two membrane bound receptors, classified in class 435, subclass 325.

Group II. Claims 92 and 94-100, drawn to cells with a receptor which has an intracellular receptor derived from an Fc receptor, classified in class 435, subclass 325.

Group III. Claims 93-100, drawn to cells with a receptor which has an intracellular receptor derived from a B cell receptor mbl polypeptide, classified in class 435, subclass 325.

The inventions are distinct, each from the other because of the following reasons:

Groups I-III are unique products. They differ with respect to their physicochemical properties and are therefore patentably distinct. Groups II and III are drawn to a cell which has one receptor that has a very specific intracellular domain while group I is drawn to a cell that has two receptors. They are patentably distinct products.

4. Because a search of any or these three distinct inventions would not be co-extensive with a search of the others, an examination and search of two or more inventions in a single application would constitute a serious undue burden on the examiner.

SPECIES

5. This application contains claims directed to the following patentably distinct species of the claimed invention.
6. The following species election is required, if Applicant elects Group I.
7. Applicant must elect a single extracellular portion and singular transmembrane portion for the first membrane bound receptor, and Applicant must elect a single extracellular portion from the second receptor.
8. Each portion of the two receptors has unique physical, chemical and biological properties, which gives each species unique enablement and search requirements. The species are therefore patentably distinct from one another.
9. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each receptor portion which prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently no claim is generic.
10. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
11. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. § 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. M.P.E.P. § 809.02(a).
12. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

Serial Number: 09/243,008

4

Art Unit: 1644

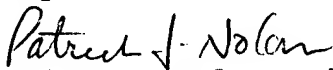
13. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

14. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor or at least one claim remaining in the application. Any amendment of the inventorship must be accompanied by a diligently-filed petition under 37 CFR 1.48 (b) and by the fee required under 37 CFR 1.17 (h).

15. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Thursday from 8:00 am to 5:30 pm.

17. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7401. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.



Patrick J. Nolan, Ph.D.
Patent Examiner, Group 1640
August 27, 1999